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Doron Tam

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EXAMINER

RANDALL, JR., KELVIN L

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,289	<b>Applicant(s)</b> TAM ET AL.	
	<b>Examiner</b> Kelvin L. Randall, JR.	<b>Art Unit</b> 3651	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 2-8 and 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 9-11, and 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Allowable Subject Matter***

1. The indicated allowability of claims 2, 9-11, and 19-25 is withdrawn in view of the newly discovered reference(s) to Benno Mossler (444,502 - hereinafter Mossler), Churchman et al. (800,072 - hereinafter Churchman), and Alois Schlumpf (4,296,873 – hereinafter Schlumpf). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 112***

2. Claim element “means for automatically stopping rotation” is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. Examiner finds that on pages 3, 4, 6, 8-10, and 13, there are various forms of elements for stopping rotation and alternatives for stopping rotation. None, of said techniques are linked clearly to said means for stopping rotation.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf, Stanley Brenner (3,503,481 – hereinafter Brenner), and Churchman.

Re Claims 1 and 19:

Mossler teaches a device for dispensing a newspaper from a stack of newspapers, the device comprising: a plate (A5) mounted on a frame (page 1 lines (63-82), said plate (A5) defining a planar newspaper-supporting surface and an opposite planar surface (see Fig. 2- opposite planar surface being the opposite side of plate A5); a rotatable shaft (B) coupled/mounted to said frame (page 2 lines 18-50); at least one roller (B') non-rotatably affixed to said shaft (B) and arranged to engage a newspaper of the stack of newspapers nearest said planar newspaper-supporting surface (A5) (see Fig. 1); means (c3) for rotating said shaft whereby said nearest newspaper is shifted over said

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at least one roller (B') (page 2 lines 88-95 and see Fig. 2- Examiner associates means for language to correspond to means as described in Applicant's Detailed Description page 6 lines 25-27); wherein the stack of newspapers is held against said planar newspaper-supporting surface (A5), and said nearest newspaper is dispensed to said opposite planar surface side of said plate (A5) (Examiner notes that once a consumer retrieves a newspaper from the dispenser in a forward direction the nearest newspaper becomes dispensed to an opposite planar surface side of the plate), said plate (A5) being disposed between said dispensed nearest newspaper and the stack of newspapers (see Examiner's previous comment) (see Figs. 1-5), but fails to specifically teach bags (Examiner notes that the claim does not specifically set forth that bags are a requirement), a means for automatically stopping rotation of said shaft after said nearest single bag has been dispensed, and the device further comprises a bag retaining element coupled to said plate for pressing the stack of bags against said at least one roller.

Schlumpf teaches bags (col. 1 lines 20-25). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler with the bags of Schlumpf because they are within the same art and are commonly recognized by one of ordinary skill in the art to be interchangeable and commonly used one in place of the other.

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Brenner teaches means (42) for automatically stopping rotation of a shaft (Examiner notes the shaft as engaging wheel (34) through rotatably journaled bearing (33)) after a single bag has been dispensed (see col. 4 lines 15-31 and col. 5 lines 40- 52).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler and Schlumpf with the means for automatically stopping rotation as noted in the Brenner disclosure, because they are in the same art and one of ordinary skill in the art in looking for a transition from a coin operated manual dispenser to a coin operate automatic dispenser would have seen the combination of the two and the use of a sensor as a means as obvious within the dispensing art. However, both Mossler and Brenner fail to teach the device further comprises a bag retaining element coupled to said plate for pressing the stack of bags against said at least one roller.

Churchman teaches the device further comprises a newspaper retaining element (23) coupled to a plate (21) for pressing the stack of newspapers against at least one roller (see Fig. 3 and page 1 lines 44-57). Re Claim 19: Churchman teaches an elongate guide mounted adjacent rollers to guide dispensed newspapers away from the rollers (see Fig.3 guide below roller). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler, Schlumpf, and Brenner with the retaining element and guide as suggested in the Churchman disclosure because they are all within the same art and

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one of ordinary skill in the dispensing art would have seen Churchman's retaining element as an obvious alternative to Mossler's retaining element (A7).

5. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf, Brenner, and Churchman, and further in view of Eugene Coleman (US 2001/0032859 – hereinafter Coleman).

Re Claims 9 and 10:

Mossler in view of Schlumpf, Brenner, and Churchman teach the device of claim 1, but fail to teach a second rotatable shaft mounted parallel to said rotatable shaft on an extension of said frame; at least one roller non-rotatably affixed to said second shaft; wherein each roller on said rotatable shaft is coupled to a roller on said second shaft, whereby rotation of said rotatable shaft causes concomitant rotation of said second shaft and a bag retaining bar.

Coleman further in view teaches a second rotatable shaft (73) mounted parallel to a rotatable shaft (71) on an extension of a frame (see Fig. 7); at least one roller (72) non-rotatably affixed to said second shaft (73); wherein each roller on said rotatable shaft (71) is coupled to a roller on said second shaft (73) (see 82 of Fig. 7), whereby rotation of said rotatable shaft causes concomitant rotation of said second shaft (see Fig. 7 and paragraphs [0055 and 0056]). Re Claim 10: Coleman teaches wherein a bag retaining element (84) includes a bag-retaining bar (top of 84) for engaging and retaining a stack of sheets against said at least one roller (70) before and during dispensing (see Fig. 7

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and paragraph [0057]). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler in view of Schlumpf, Brenner, and Churchman with Coleman's disclosure because they are within the same art one of ordinary skill in the art looking for a commercial or public use dispenser would see the combination as a way to increase the efficiency of the dispenser.

2. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf, Brenner, Churchman, and Coleman, and further in view of Roy Hawley (1,988,732 – hereinafter Hawley).

Re Claims 11:

Mossler in view of Schlumpf, Brenner, Churchman, and Coleman teach the device of claim 1 including a bag retaining bar (top of 84) and a bag retaining arm (84) (see Coleman Fig. 7), but fail to teach wherein an arm is pivotally coupled to said plate.

Hawley further in view teaches wherein an arm (42) is pivotally coupled to a plate (rear wall). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler in view of Schlumpf, Brenner, Churchman, and Coleman with the pivot connection of Hawley so as to provide an alternative means for biasing a stack as commonly known within the dispensing art.



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3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf.

Re Claim 20:

Mossler teaches a method for dispensing a newspaper from a stack of newspapers, the method comprising: holding a stack of newspapers against at least one roller (B') non-rotatably affixed to a rotatable shaft (B) coupled to a plate (A5) mounted on a frame (page 2 lines 18-50- Examiner notes coupled through frame) and defining a planar newspaper supporting surface and an opposite planar surface (see Fig. 2); dispensing one newspaper from said stack of newspapers nearest said planar newspaper supporting surface to said opposite planar surface of said plate (A5) (Examiner notes that once newspapers is dispensed it is capable of being held/dispensed to an opposite planar surface of said plate) by rotating said rotatable shaft (see page 6 lines 25-27, and Figs. 1-5); and automatically stopping rotation of said shaft after dispensing said nearest one bag (Examiner notes that only one newspaper is dispensed at a time thus automatically stopping after 1<sup>st</sup> newspaper is dispensed), but fails to teach of bags.

Schlumpf teaches bags (col. 1 lines 20-25). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler with the bags of Schlumpf because they are within the same art and are commonly recognized by one of ordinary skill in the art to be interchangeable and commonly used one in place of the other.

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4. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf and further in view of Brenner.

Re Claims 21-23:

Mossler in view of Schlumpf teaches the device of claim 20 and dispensing of a nearest newspaper, but fail to teach wherein said step of automatically stopping includes detecting presence of a dispensed bag adjacent a dispensed bag detector; and stopping rotation of said shaft in response thereto.

Brenner teaches wherein said step of automatically stopping includes detecting presence of a dispensed bag adjacent a dispensed bag detector (42) ; and stopping rotation of said shaft in response thereto (col. 5 lines 47-53). Re Claim 22: Brenner teaches drivingly coupling a motor (34) to said rotatable shaft (100), such that actuation of said motor cause said rotatable shaft to rotate; and causing said at least one roller (32) to engage one bag in said stack of bags, such that rotation of said rotatable shaft causes said at least one roller to remove said bag from said stack of bags (col. 4 lines 15-53). Re Claim 23: Brenner teaches wherein said step of automatically stopping includes automatically stopping said motor in response to dispensing a single bag from the stack (col. 5 lines 47-53). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler and Schlumpf with the means for automatically stopping rotation as noted in the Brenner disclosure, because they are in the same art and one of ordinary skill in the art in looking for a transition from a coin operated manual dispenser

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to a coin operate automatic dispenser would have seen the combination of the two and the use of a sensor as a means as obvious within the dispensing art.

5. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mossler in view of Schlumpf and further in view of Coleman.

Re Claims 24 and 25:

Mossler in view of Schlumpf teaches the device of claim 20 and dispensing of a nearest newspaper, but fail to teach wherein at least one roller is non-rotatably affixed to a second rotatable shaft, said second shaft is mounted parallel to said rotatable shaft, and said at least one roller on said rotatable shaft is coupled to said at least one roller on said second shaft, whereby rotation of said rotatable shaft causes concomitant rotation of said second shaft.

Coleman further in view teaches a second rotatable shaft (73) mounted parallel to a rotatable shaft (71) on an extension of a frame (see Fig. 7); at least one roller (72) non-rotatably affixed to said second shaft (73); wherein each roller on said rotatable shaft (71) is coupled to a roller on said second shaft (73) (see 82 of Fig. 7), whereby rotation of said rotatable shaft causes concomitant rotation of said second shaft (see Fig. 7 and paragraphs [0055 and 0056]). Re Claim 25: Coleman teaches drivingly coupling a manual (86) rotation means to said rotatable shaft, such that actuation of said manual

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rotation means rotates said shaft (see Fig. 7). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have been motivated to combine the teachings of Mossler in view of Schlumpf with Coleman's disclosure because they are within the same art one of ordinary skill in the art looking for a commercial or public use dispenser would see the combination as a way to increase the efficiency of the dispenser.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin L. Randall, JR. whose telephone number is (571)270-5373. The examiner can normally be reached on Monday-Friday 8:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571)272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gene Crawford/  
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